

REMARKS

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

Double Patenting

It is noted that Applicant intends to submit a terminal disclaimer. To date, a terminal disclaimer has not been received.

A terminal disclaimer will be submitted when prosecution on the merits is concluded.

4. Claims 15-23 rejected under 35 U.S.C. 102(b) as being anticipated by Heller (3,565,213). Heller discloses a lubricator to apply lubricant to a strand (20) as it is pulled through a conduit, the lubricator including a coupling feature (14) to mate with a corresponding coupling feature (corresponding threads) of a bushing;...

Response to Arguments

6. Applicant's arguments filed 12/7/05 have been fully considered but they are not persuasive.

Applicant argues that the Examiner has mistakenly relied upon one piece to be both a conduit and a bushing. First of all, the claims are not limiting in this regard. In other words, the claims do not require them to be separate members. In Heller, there is a threaded portion which threads into a coupler (15) at one end and has a guiding member for the wire which acts as a bushing since it guides the wire to be lubricated into the central chamber to receive an application of a lubricant. The two rejected independent claims are repeated below:

Claim 15

Apparatus comprising:

a lubricator to apply lubricant to a strand as it is pulled through the lubricator and a conduit, the lubricator including a coupling feature to mate with a corresponding coupling feature of a bushing.

It is clear that Heller anticipates this claim. The device is a lubricator which has two end pieces which are threaded into a central piece (16) which applies lubricant to a cable (20). The language of claim 15 is not commensurate in scope to Applicant's arguments. The Examiner is not "having it both ways" since the claim is not limiting to the member (12 in Heller) is two pieces). Please also note that "to mate" is functional and to meet the claim, the prior art must only be capable of performing the function.

Claim 15 has been amended. Heller does not describe a lubricator that includes both "a coupling feature on an internal wall of one end of the lubricator to match ... the conduit" and "a coupling feature on an external wall of another end to match ... a separate bushing," in which the lubricator, conduit, and bushing are all "separate" parts.

Items 10 and 11 in Heller are clearly both conduit, and there is no separate bushing. Even if one of 10 or 11 were the conduit and the other the bushing, the lubricator 16 has coupling features to match them only on its internal walls, and neither 10 nor 11 has a coupling feature on its internal wall.

[claim 23:] a lubricator to apply lubricant to a strand as it is pulled through a conduit, the lubricator including an external thread to mate with a corresponding internal thread (14) of a bushing, and an internal thread (15) to mate with a corresponding external thread (13) of the conduit.

Claim 23

Apparatus comprising

a lubricator to apply lubricant to a strand as it is pulled through a conduit, the lubricator including an external thread to mate with a corresponding internal thread of a bushing, and an internal thread to mate with a corresponding external thread of the conduit.

Again note that "to mate" is functional and to meet the claim, the prior art must only be capable of performing the function. This claim only requires that the lubricator have an internal and external thread. The rest is functional and as long as the applied reference is capable of meeting the functional limitations, the claim is anticipated. In this case, the Examiner asserts that the Heller is, in fact, capable of performing the recited functions.

Claim 23 has been amended. Heller does not disclose a lubricator that has both "an external thread to match a corresponding internal thread of a bushing" and "an internal thread to match a corresponding external thread of the conduit" where the bushing and conduit are "separate" from the lubricator.

The only elements of Heller that have an external thread are the conduits 10/11 and the nozzle 22, and the only element that has an internal thread is the coupler 16. No element has both kinds of thread, whatever each element is called.

Allowable Subject Matter

5. Claims 36-37 are allowed.

The applicant acknowledges that claims 36 and 37 are patentable. The applicant notes again that the examiner has **never addressed claim 38**. (The office action of September 30, 2004, indicated that claim 38 was pending and rejected, but included no grounds for the rejection; the office action of July 11, 2005 did not indicate that claim 38 was pending.) Claim

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38 has never been cancelled, was amended in the reply to the previous office action in a similar manner to claim 36, and is believed to be patentable for the same reasons as claim 36.

[claims 16-22:] the strand comprises an insulated electrical wire or the like; the coupling feature of the lubricator comprises threads', the threads comprise external threads; the lubricator also includes a second coupling feature (15) configured to mate with a corresponding coupling feature of the conduit; the second coupling feature of the lubricator comprises threads; the threads comprise internal threads; a body of the lubricator is formed of two connectable components (16, 11),.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

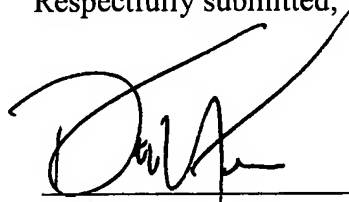
Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

Enclosed is a \$60 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

6/27/0



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